

Remarks

Applicant has amended claim 1 to include the features of claim 2. Claims 2 and 6 (dependent from claim 2) have been deleted. Claims 3 and 4 were amended to rectify claim dependency. No new matter has been added.

Applicant believes that claim 1 as previously pending is different from the combined teachings of the '614 and '014 references. Nevertheless, claim 1 has been amended to further distinguish the differences between the claimed invention and the features of a composition resulting from the combination of the '614 and '014 references.

Comments on Impropriety of the Finality of the Office Action

The Examiner indicated that claims 1-8 "remain rejected" over the combination of JP 57-206614 and JP 61-260014. Applicant notes, however, that claims 3, 5 and 7 were previously allowed (see page 3 of the Office Action mailed September 26, 2002 (paper 6)). In view of the previous allowance of claims 3, 5 and 7, the instant Office Action represents a first rejection of these claims.

Accordingly, the finality of the Office Action is improper; Applicant respectfully requests that the finality of the rejection be withdrawn.

Rejections Under 35 U.S.C. §103

The Examiner maintained the rejection of claims 1-8 under 35 U.S.C. §103(a) as being unpatentable over JP 57-206614 (hereinafter JP '614) in view of U.S. Patent No. JP 61-260014 (hereinafter JP '014). As noted above, the rejection with respect to claims 3, 5 and 7 was not maintained; this is the first rejection of claims 3, 5 and 7. Applicant respectfully traverses the rejection.

First, Applicant asserts that elements of Applicant's claims, particularly claim 1, are nowhere to be found in the '614 reference or the '014 reference or in the combination of these two references. The Examiner has not indicated where in these references the elements can be

found, and therefore the *prima facie* obviousness of the claimed invention has not in fact been demonstrated. Although the Examiner stated that “the features upon which applicant relies (i.e., the water retention characteristics) are not recited in the rejected claims(s)” (Office Action at page 4), Applicant respectfully notes that claim 1 recites these features by reciting a specific quantity of heat required for the evaporation of water under specified conditions. Therefore, the water retention characteristics of Applicant’s invention are present in the claims, but are not found in either of the cited references.

More specifically, neither the ‘614 nor the ‘014 references have a description of the adhesive preparation according to the presently claimed invention, which controls the heat quantity required for water evaporation (hereinafter referred to as the “water evaporation heat”) by adding glycol(s) and/or polyhydric alcohol(s), thereby greatly improving the “comfortable refreshing feeling in use” and “user satisfaction after peeling off”. Page 3 (lines 15-16), page 6 (lines 11-16) and page 7 (lines 10-14) of the specification describe this in greater detail.

Second, the Examiner stated that it is *prima facie* obvious to combine the ‘614 and the ‘014 references because the products of these two references are taught to be useful for the same purpose. The Examiner stated that the compositions of the ‘614 and ‘014 references are useful for providing a persistent cooling sensation when applied to the skin. Both of the compositions taught by these references utilize hydrophilic polymers that retain water to provide this sensation. Therefore, one of ordinary skill in the art would expect that the combination of these products would be a product containing one or more water-retentive polymers. Such a composition would be expected to retain water, not to release it to provide a cooling effect, in view of the disclosure of the ‘614 reference that the disclosed compositions provide a cool sensation for hours “because of its high water retention” (see last line of abstract).

No other features of the compositions are taught or suggested to effect the cooling sensation. Thus the Examiner’s contention that “the expected result is a sheet-form preparation comprising a polyhydric alcohol” cannot be considered true. Instead, the Examiner’s selection

of an element (a polyhydric alcohol) from the '014 reference to add to the elements of the '614 composition can only be the result of a hindsight reconstruction of Applicant's claimed invention.

Polyhydric alcohol(s) as described in the '014 reference is one of the essential ingredients in the base for the hydrous patch of that reference. Moreover, the polyhydric alcohol(s) as described in the '014 reference is used as a dispersant. Therefore, one of ordinary skill in the art would not use polyhydric alcohol(s) as described in the '014 reference to incorporate it in the poultice disclosed in the '614 reference with a view to control water retention and dispersion thereof. Thus, as opposed to the Examiner's view, Applicant is of the opinion that there is no motivation for a person skilled in the art to combine the features of the '014 and '614 references in order to formulate the adhesive preparations as presently claimed.

Further support for the nonobviousness of the claimed invention in view of the '614 and '014 references is provided in the data attached as Exhibit 1: Evidence for lack of motivation to combine '614 and '014. Exhibit 1 includes Fig. 3 of the '614 reference and an English translation of the description associated with the figure.

The water evaporation heat in the poultice described in Example 1 of the '614 reference can be calculated as more than 29.1 cal, based on the following formula in view of the formula described in Applicant's specification:

$$583.1 \times (0.5\text{g} \times 100 \times 10\%) \times 1/100 \text{ cm}^2$$

wherein each parameter indicates the following:

583.1	water latent heat (cal/g);
0.5g	weight of the support body;
100	relative amount of water that can at least be contained in the support body

	with respect to the weight of the support body, which is defined as 1;
10%	percentage evaporation rate of water with respect to the initial amount of
	water contained in the support body (read from '614 Fig. 3 at 0.5 H), and
100 cm ²	area of the support body.

The evaporation heat for the composition of the '614 reference (more than 29.1 cal) is more than twice as large as the upper limit set forth in claim 1 of the present application. This means that the poultice disclosed in the '614 reference needs ingredient(s) to suppress water release and diffusion so that the poultice meets the requirement as set forth in claim 1 of the present application.

However, there is no description in the '014 reference regarding ingredients that suppress water evaporation. Although there is indeed a description of polyhydric alcohols in the '014 reference, as the Examiner has noted, polyhydric alcohols as contained in the patch-disclosed in the '014 reference are utilized as a dispersant, and therefore there is no description or suggestion in the '014 reference that polyhydric alcohols can suppress water evaporation.

Therefore, there is no motivation to combine the teachings of the '614 and the '014 references in order to constitute the present invention.

In view of the foregoing, Applicant's claimed composition has different water release properties than the compositions of the '614 or the '014 references or any reasonable combination of these compositions. The presently claimed invention features control of water evaporation heat rather than dissipation of water per se.

Accordingly, in view of the reasoned statements above, withdrawal of the rejection of the claims under 35 U.S.C. 103(a) is respectfully requested.

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CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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